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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:

Appellants : Tomonori FUJISAWA et al.
Title : INFORMING SYSTEM
Serial No. : 10/521,580
Filed : January 18, 2005
Group Art Unit : 2142
Confirm. No. : 4028
Examiner : Jason RECEK

REPLY BRIEF UNDER 37 CFR § 41.41

Date: February 26, 2010

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed pursuant to 37 CFR § 41.41.

REPLY

In this Examiner's Answer, the Examiner maintains the rejection of Claims 5 and 9 under 35 U.S.C. 103(a) as being unpatentable over Orime et al. JP 2002-183365 A (as translated)

in view of Felman US 2002/0152265 A1. This rejection is again traversed.

This Examiner's Answer acknowledges that, in connection with claim 5, Orime does not explicitly disclose:

wherein said reporting E-mail includes a plurality of choices for re-informing methods ... choices comprising placing a call to a first telephone number ... and placing a call to a second telephone number
...

However, the Examiner then takes the position that the above is taught by Felman as a system that sends an email containing a telephone number and cites paragraph [0051].
(Emphasis added)

In traverse, it is pointed out that paragraph [0051] of Felman is such as to disclose:

[0051] For instance, as in FIG. 8, the querying party (Sam) may request an e-mail address of a long friend (Tom). **The system sends a 44 query notification signal to the listing party's cellular telephone phone** equipped with a screen display (the 56 telephonic peripheral) prompting the 12 listing party (Tom) that he has **received a query for personal information** and further providing identifying information about the caller. The message may say, ("Sam Smith from Springfield High School requests your personal information. Please hit 1 if you wish to provide him with your cellular telephone number by telephone.") Using his

cellular phone, the 12 listing party sends a 46 **consent/no consent signal** (by hitting 1 on his cellular phone) to send his telephone number. The 18 bridge website server has a stored message which is sent by means of a 50 personal contact information signal (an Internet phone call or a phone call) that is sent to the 10 querying party. The 10 querying party picks up the phone, hears a message "Tom can be reached at his cell phone at 737-459-9293," records the number, and **immediately calls Tom's cellular phone** and reaches him on the golf course. **Or**, as in FIG. 5, while Tom is on the golf course, **after receiving the phone call notifying him that Sam seeks his personal contact information**, may hear a message "Please hit 2 if you wish to e-mail Sam Smith your cellular telephone number." Then, from the golf course, Tom hits 2, and the 18 bridge website server sends Sam an e-mail to Sam's computer containing his cellular telephone number. **Having Tom's cellular number, Sam calls up his long lost friend Tom at the golf course.** (Emphasis added)

It is not seen that this supports the position taken by the Examiner nor makes sense in that only if it is this particular "Tom", who is the long lost friend but whose cell number is mysteriously known somehow to the "system", is willing to divulge his e-mail data, will "Sam" be provided with this data. The last two sentences make even less sense in that,

irrespective of what is presumed to be the "system" having already called Tom on his cell phone (which must require the cell phone number), Sam has to be provided with Tom's cellular telephone number so that he can now call Tom (on his cell phone).

The position that this (rather confusing) disclosure would lead the person of ordinary skill to modify Orime in the manner purported in this rejection is submitted as being untenable. Indeed, the only reason for process which is disclosed in the above quoted section of Felman would be to assuredly provide the option to not consent to the submission of data and to ignore both the call and the request. The incompatibility of this with the scheduling intentions of Orime is self-evident.

Further, the Examiner indicates that although Felman does not explicitly teach sending multiple telephone numbers this would have been obvious since the purpose of the invention is to get in contact with someone and there is a greater chance of success if all of their contact information is available.

However, paragraph [0039] of Felman is such as to teach:

[0039] This invention, a 9 web-based personal contact information system, is shown in FIG. 1(a). It is comprised of a method and apparatus for connecting a 10 querying party to a 12 listing party without divulging the personal information of the 12 listing party unless voluntarily revealed by the 12 listing party. FIG. 1(a) shows the most preferred embodiment of the invention. Both the 10 querying party and the 12 listing party are using computers connected to the Internet. (Emphasis added)

If these teachings were to be applied to the system disclosed in Orime then it would be rendered at least partially inoperative for its intended purpose. That is to say, as pointed out in the Abstract of Orime:

In this organizer proxy system for connecting a WWW server 103 and a mail server 105 to an information network 101 connected to clients 102, 104 and 106, the WWW server 103 holds an attendance candidate management unit for managing the attendance candidates by grouping stipulated by the organizer and a meeting management unit for managing the meeting guide information in relation to the meeting to be held by the organizer, and the meeting guide information is automatically informed to the attendance candidates, and attendance and non attendance of the attendance candidates is automatically counted.

Thus, it is clear that the calling and information collection process that is disclosed in Felman is not of any use in Orime in that all contact information of all possible candidates would already be known and need not be sought out. Not only that, but in Felman the option to not reply is clearly provided, viz., the "consent/no consent" option. The rejection fails to acknowledge this disclosure and the influence that it would have on the reader of ordinary skill.

The Examiner indicates that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a telephone number over email as taught by Felman for the purpose of attempting to contact an invitee who has not

responded. The motivation is advanced as being to allow the organizer to easily retry the users who have not confirmed. Orime is indicated as teaching that meetings can be organized by telephone (paragraphs 3-4).

However, the disclosure of Felman would suggest that if there is no response, that this might well be an option that the receiving party has opted for (viz., opted for the no consent option) in the interest of privacy or the like type of reason. The reason to retry to contact would therefore be basically obviated.

Further, the above-mentioned organization via telephone is disclosed as being the basic problem that the prior art encounters and which had led to the development of the Orime invention. As to attempting to contact an invitee that has not responded, there is no disclosure of a problem arising because of somebody not responding in Orime. It thus appears, without disclosure to the contrary, that either everybody responds one way or the other, or a non-response is taken as an indication of non-attendance. There is no hint of attempting multiple contacts or any hint that there is any such thing as an absence of a reply that would prompt further action. Indeed, the automatic counting of the attending candidates which is disclosed as a feature in Orime would be interrupted and significantly delayed if retries were to be contemplated.

Most certainly the nuance of the Felman disclosure (as noted above) would not lead the person of ordinary skill to consider the teachings of Felman in combination with Orime and this thus renders the proposed combination of these references moot for the purposes of rendering the claimed subject matter obvious under § 103.

In connection with claim 9, the Examiner has indicated:

Orime discloses "'preparing a list of informed persons not having check a transmitted message, and means for periodically reporting the list to the informing person" as transmitting an email to the manager that indicates whether to perform a meeting based on the participants response (paragraph 33).'

However, paragraph [0033] of Orime is such as to disclose:

[0033]If the time (manager deadline ID) of the manager deadline set up beforehand comes, it will determine whether e-mail transmitted to a manager and perform a meeting from a prospective participant's schedule. Since a holding place can be reserved and the information on intervention is also notified to a holding place in that case, a manager does not need to take contact of the number to a holding place anew. Mail of the completion of a request to print out files is automatically distributed to a manager after that, and a manager checks that the request to print out files of a holding place has been made.

As will be appreciated, the translation of the Orime reference leaves a lot to be desired, nevertheless it is relied upon by the Examiner as a basis of the rejection. Irrespective of this, it is not seen that this paragraph discloses that which is purported. The word "periodic" or anything like it, is absent and it cannot serve as a basis for the rejection of claim 9, as it currently stands.

In the Examiner's response to the Appellants' arguments, the Examiner appears to rely on the claim language as a means to rebut the arguments that were advanced. For example, it is

stated that nowhere does claim 5 require placing a call, let alone "a system" to place a call.

However, it does. Claim 5 recites:

said **service server comprises means** for detecting data concerning said response column transmitted by each of the terminal devices owned by said informed persons, and **means for transmitting a result of detection as a reporting E-mail** to the terminal device owned by said informing person, and

said **reporting E-mail** includes a plurality of choices for re-informing methods to the informed persons, said plurality of choices comprising **placing a call to a first telephone number**

While the word "system" is not used *per se*, it is submitted that the plurality of means included in the service server amounts to a system and this "means" within the service server places a call in the manner recited.

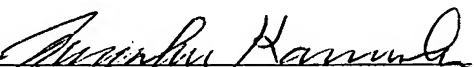
The rejection is submitted as being defective for at least the reasons advanced above.

CONCLUSION

Accordingly, Appellants respectfully maintain that the rejection of claims 5 and 9 is in error, and request that the final rejection be reversed.

Respectfully submitted,

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